

combine reference teachings to arrive at the claimed invention. Third, there must be a reasonable expectation of success. M.P.E.P. § 2142. Applicant respectfully submits that the Office Action does not make a *prima facie* case of obviousness, because even if combined, Rothmuller and Kostreski fail to teach or suggest all of the elements of claims 1-12 and 19-29. Applicant also respectfully submits that there is no suggestion or motivation to modify Rothmuller, or to combine Rothmuller and Kostreski. Therefore, claims 1-12 and 19-29 are patentable over Rothmuller in view of Kostreski.

Claims 1-7

Claims 1-7 recite “one or more favorite channel lists, the favorite channel lists comprising one or more...channels relating to the user specified theme” (emphasis added). The Office Action states that “Rothmuller discloses a computer system for managing favorite channels (Fig. 1) based on a user specified theme (Col. 1, lines 35-39).” Applicant respectfully disagrees. Fig. 1 of Rothmuller illustrates an apparatus capable of generating a program guide based only on the name or title of the program. Lines 35-39 of Col. 1 of Rothmuller teach that a user may sort channel guides either by predefined themes, or alternatively, by user defined lists. However, Rothmuller does not teach or suggest favorite channel lists including one or more channels relating to a user specified theme, as recited in claims 1-7. In Rothmuller, a user can define a list, but cannot specify a theme, for sorting the channel guide; if the user desires to sort the channel guide by a theme, the user must select a predefined theme. Kostreski also does not teach or suggest favorite channel lists including one or more channels relating to a user specified theme, as recited in claims 1-7. Kostreski is directed to dynamic programming of a digital entertainment terminal and does not contain any disclosure of favorite channel lists.

Claims 1-7 also recite “a favorites database for storing one or more favorite channel lists.” The “favorite channel lists” include one or more logical channels relating to the user specified theme. The Office Action argues that Rothmuller teaches or suggests the “favorites database” of claims 1-7. Applicant respectfully disagrees. As discussed above, Rothmuller and Kostreski do not teach or suggest favorite channel lists including one or more channels relating

to a user specified theme, as recited in claims 1-7. Therefore, Rothmuller and Kostreski also do not teach or suggest the “favorites database” for storing these lists.

Further, claims 1-7 recite “one or more favorite channel lists, the favorite channel lists comprising one or more logical channels relating to the user specified theme” (emphasis added). Each logical channel uniquely identifies a corresponding physical channel. As correctly stated in the Office Action, “Rothmuller does not clearly disclose one or more logical channels of the favorite channel list related to user specified theme.” However, the Office Action states that “Kostreski shows one or more logical channels (Fig. 5 and Col. 28, lines 40- Col. 29, lines 34.” Applicant respectfully disagrees. Neither Fig. 5 nor the rest of the disclosure of Kostreski teach one or more logical channels that uniquely identify corresponding physical channels. Kostreski teaches a primary channel map 500 and a secondary channel map 520. A secondary channel map exists for each VIP 504. Thus, Fig. 5 of Kostreski shows one secondary channel map 520a for VIP “Star Sight,” and another secondary channel map 520b for VIP “BVS.” The “PROGRAM,” “RF,” and “PID” columns of secondary channel maps 520a and 520b show corresponding sets of entries for channels listed in the “SEL.” column. Each channel listed in the “SEL.” columns of secondary channel maps 520a and 520b, however, does not uniquely identify a corresponding physical channel. For example, “SEL.” channel 13 of secondary channel map 520a corresponds to “PROGRAM” TOP GUN, “RF” 100, and “PID” 0F31. However, the same “SEL.” channel 13 on secondary channel map 520b corresponds to “PROGRAM” NHL , “RF” 100, and “PID” 07D6. Thus, Kostreski does not teach or suggest the “logical channels” recited in claims 1-7 because the “SEL.” channels do not uniquely identify corresponding physical channels.

For these reasons, Applicant respectfully submits that the Office Action fails to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), because even if combined, Rothmuller and Kostreski fail to teach or suggest all the elements of claims 1-7.

Applicant also respectfully submits that there is no suggestion or motivation to modify Rothmuller, or to combine Rothmuller and Kostreski. The fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP § 2143.01. However, neither Rothmuller nor

Kostreski suggests the desirability of the combination of their respective teachings. Rothmuller is directed to sorting and searching television program guides, whereas Kostreski relates to dynamically programming a digital entertainment terminal to offer various broadband services.

Claims 8-12

The Office Action states that Rothmuller and Kostreski teach or suggest all the elements of claims 8-12 based on the same analysis as claims 1-7. Applicant respectfully disagrees.

Claims 8-12 recites “one or more favorite channel lists, the favorite channel lists comprising one or more logical channels relating to a user specified theme.” As discussed above with respect to claims 1-7, Rothmuller and Kostreski do not teach or suggest this element recited in claims 8-12.

Claims 8-12 also recite “channel map services to map a logical channel number in the favorite channel list to a physical channel number on a physical device.” As discussed above with respect to claims 1-7, Rothmuller and Kostreski do not teach or suggest “logical channels”. Therefore, Rothmuller and Kostreski also do not teach or suggest “channel map services” to map a logical channel number in the favorite channel list to a physical channel number on a physical device.

Further, claims 8-12 recite “electronic program guide content services to determine what is programmed on the logical channel and to call channel map services to determine the corresponding physical channel and physical device.” As discussed above, Rothmuller and Kostreski do not teach or suggest “logical channels” or “channel map services”. Therefore, Rothmuller and Kostreski also do not teach or suggest the “electronic program guide content services” element recited in claims 8-12.

Applicant respectfully submits that the Office Action does not make a *prima facie* case of obviousness under 35 U.S.C. § 103(a), because even if combined, Rothmuller and Kostreski fail to teach or suggest all the elements of claims 8-12. Applicant also respectfully submits that, as argued earlier, there is no suggestion or motivation to modify Rothmuller, or to combine Rothmuller and Kostreski.

Claims 19-23, 25-29

The Office Action states that Rothmuller and Kostreski teach or suggest all the elements of claims 19-23 and 25-29 based on the same analysis as claims 1-7. Applicant respectfully disagrees.

Claims 19-23 and 25-29 recite “identifying one or more channels showing an event of a user specified theme, wherein the step of identifying is achieved by matching one or more event themes from an electronic program guide (EPG) content database to the user-specified theme” and “including each one of the channels in a favorite channel list.” As discussed above, neither Rothmuller nor Kostreski teach or suggest identifying one or more channels showing an event of a user specified theme, or including each one of the channels in a favorite channel list.

Applicant respectfully submits that the Office Action does not make a *prima facie* case of obviousness under 35 U.S.C. § 103(a), because even if combined, Rothmuller and Kostreski fail to teach or suggest all the elements of claims 19-23 and 25-29. Applicant also respectfully submits that, as argued earlier, there is no suggestion or motivation to modify Rothmuller, or to combine Rothmuller and Kostreski.

Claim 24

The Office Action states that Fig. 1 and Col. 4, Lines 17-54 of Rothmuller teach or suggest all the elements of claim 24. Applicant respectfully disagrees.

Similar to claims 19-23 and 25-29, claim 24 recites “identifying one or more channels showing an event of a user specified theme and including each one of the channels in a favorite channel list.” For the same reasons discussed above, neither Rothmuller nor Kostreski teach or suggest identifying one or more channels showing an event of a user specified theme and including each one of the channels in a favorite channel list.

Applicant respectfully submits that the Office Action does not make a *prima facie* case of obviousness under 35 U.S.C. § 103(a), because even if combined, Rothmuller and Kostreski fail to teach or suggest all the elements of claim 24. Applicant also respectfully submits that, as argued earlier, there is no suggestion or motivation to modify Rothmuller, or to combine Rothmuller and Kostreski.

Summary

For the foregoing reasons, Applicant respectfully submits that the Office Action fails to establish a *prima facie* showing of obviousness under 35 U.S.C. § 103. Therefore, Applicant respectfully requests reconsideration and allowance of pending claims 1-12 and 19-29.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612-373-6954) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 50-0439.

Respectfully submitted,

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